

**REMARKS**

After entry of the above amendments, the claims pending in the subject application are 19-37. Reconsideration of this application based on the Amendments and Remarks presented herein is respectfully requested.

It is acknowledged that claims 23 and 24 would be allowable if rewritten in independent form.

In the IDS, the reference to United States Patent No. 4,449,954 should have been to United States Patent No. 4,444,954. This patent was referenced at page 19, line 21 as providing examples of blocking agents for polyisocyanates.

The specification was amended to insert the Greek letters  $\alpha$ ,  $\delta$ , and  $\epsilon$ . Support for this amendment can be found in the priority document. In the publication of the priority document (DE 199 44 483), support can be found at column 14, lines 58 and 66, and column 15, lines 48, 56, and 64.

The addition of claim 37 does not result in a total number of claims greater than previously paid for. In the event that Applicants have overlooked the need for a claim fee, the Director - U.S. Patent and Trademark Office is hereby authorized to charge Deposit Account 23-3425 the claim fees necessary for entry of this amendment. Support for claim 37 can be found on page 62, lines 1-6.

To be more clear, the claims have been amended to delete the term "aqueous" as an adjective for compositions after the compositions have been cured in the process. While the compositions can be aqueous before curing, they are no longer aqueous after curing. The term "bright" has been replaced with "having a color that is matched to a color of a basecoat". This concept is described at page 50, lines 21-25. Also, the term "parts" has been replaced by "part" to indicate that the term refers to one or more.

**35 U.S.C. §112 REJECTIONS**

Claims 23-26, 32, and 35-36 were rejected under 35 U.S.C. §112, second paragraph.

In claim 23, the term "electrically conductive aqueous primer" is used, but in claim 19, the term appears in more than one part of the claim. Claim 23 has been amended to indicate that the term applies to each occurrence of the term in claim 19.

In claim 25, the term "the aqueous primer having a color that is matched to a color of an aqueous basecoat material" is used, but in claim 19, the term appears in more than one part of the claim. Claim 25 has been amended to indicate that the term applies to each occurrence of the term in claim 19.

Claim 32 recites "i) thermally and ii) both thermally and with actinic radiation", which is the same limitation as in claim 19. Claim 32 has been amended to delete the "i) thermally" only.

Claim 35 recites that the substrate is "uniformly covered over its entire surface by the primer system". This indicates that there is no uncoated surface on either the metal parts and/or the plastic parts. Claim 35 has been amended to more clearly recite the primer layers for the metal parts and the plastic parts and that each is fully covered. Also, claim 35 has been amended to more clearly recite that the substrate is part of the claim.

Therefore, it is respectfully submitted that claims 23-26, 32, and 35-36 are not indefinite.

**35 U.S.C. §102 REJECTIONS**

Claims 34-36 were rejected under 35 U.S.C. §102(b) as being anticipated by United States Patent No. 4,756,975 to Fuji et al.

Claims 34 and 35 have been amended to claim structures that have the primer coat that has a color that is matched to a color of the basecoat. Fuji '975 does not disclose or suggest the

color matching of the primer layer and the basecoat layer. Therefore, it is respectfully submitted that claims 34-36 are not anticipated by United States Patent No. 4,756,975 to Fuji et al.

### 35 U.S.C. §103 REJECTIONS

Claims 19-22, 25-27, 30, and 32-33 were rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 4,756,975 to Fuji et al.

Claim 19 has been amended to recite that in steps 1) b) or 1) c), the primer coat is color matched to the basecoat. Fuji '975 does not disclose or suggest the color matching of the primer layer and the basecoat layer. As for step 1) a), the limitation of "the electrocoat film on the at least one metal part was thermally cured at a temperature of less than 100°C" has been added to d) i). Fuji '975 discloses that the electrocoat layer is cured at a temperature of 100°C to 210°C (column 4, lines 66-68). There is no disclosure or suggestion of curing the electrocoat at a temperature of less 100°C, and in particular at 50-90°C (claim 37) in Fuji '975. Therefore, it is respectfully submitted that claims 19-22, 25-27, 30, and 32-33 are patentable over United States Patent No. 4,756,975 to Fuji et al.

Claims 28-29 and 31 were rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 4,756,975 to Fuji et al. in view of United States Patent No. 6,291,564 to Falcr et al. Claims 28-29 and 31 depend from independent claim 19. From above, claim 19 is patentable over the cited references. Therefore, claims 28-29 and 31 are patentable over the cited references.

In view of the amendments and remarks contained above, Applicants respectfully request reconsideration of the application, withdrawal of the 35 USC §102, §103, and §112 rejections, and request that a Formal Notice of Allowance be issued for claims 19-37. Should the Examiner have any questions about the above remarks, the undersigned attorney would welcome a telephone call.

Respectfully submitted,

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